

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDEL

Ser. No.: **09/833,956**

Filed: **April 12, 2001**

For: **SYSTEM AND METHOD FOR LIST
SHOPPING OVER A COMPUTER
NETWORK**

Group Art Unit: **3685**

Examiner: **John M. WINTER**

Attorney File No.: **LH 011**

Confirmation No.: **3820**

Decision on Appeal Mailed On: **7/22/2010**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

This paper is Applicant's Request for Rehearing under 37 C.F.R. § 41.52. It is filed within two months of the notification date of the Decision on Appeal in this case, and therefore is timely.

Authorization is hereby granted to charge all fees necessary to file this paper and applicable to a small entity to Deposit Account No. 50-3196.

I
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-17 have been canceled.

Claims 18-38 are pending in the application.

Claims 18-38 have been rejected.

Applicant appealed from the rejections of claims 18-38.

The Board reversed the rejection of claim 21, and affirmed the rejections of claims 18-20 and 22-38.

II
GROUND OF REJECTION REVIEWED ON APPEAL AND POINTS
URGED IN THIS REQUEST FOR REHEARING

Claims 18-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gavarini, U.S. Patent Number 7,080,070 (“Gavarini” in this paper) in view of Wells, U.S. Patent Number 6,711,586 (“Wells”).

In this Request for Rehearing, Applicant respectfully submits that the Board has overlooked certain points relating to claims 28, 34, and 36, which Applicant argued in the Appeal and Reply Briefs.

III **ARGUMENT**

A. Claim 28

Claim 28 reads thus:

28. The method according to Claim 18, wherein the step of searching comprises the step of:

searching certain data sources of the plurality of data sources in a prioritized order specified by the user.

In the Appeal Brief, we argued that Gavarini's disclosure of alphabetic browsing does not meet the limitation of claim 28 requiring searching the plurality of data sources in a prioritized order specified by the user.¹ The specific text cited by the Examiner is set forth below:

Specifically, regardless of the browsing mode (alphabetic browsing, category-based browsing, search, etc.), whenever the user views an item or a list of items, each such item is displayed in conjunction with a "quantity" field which indicates the number of that item currently selected for purchase.

Gavarini, col. 2, lines 45-50. This text refers to alphabetical browsing of items.

The Board affirmed the rejection of this claim "because by the user specifying searching alphabetically, this gives priority of one category over the other based on a given letter placement of the categories involved in the search in Gavarini." Decision on Appeal at 7. The Board apparently concluded that "prioritized order specified by the user" refers to the order of the items. Claim 28, however, requires prioritizing sources – not items – in the order specified by the user. In fact, the claim does not even include the words *item* or *items*, so *prioritizing* cannot reasonably be construed as applying to items.

¹ This is a verbatim characterization of our argument on page 7 of the Board's Decision.

Note that the specification describes prioritizing sources. For example, “[a]t step 18, the shopper chooses and prioritizes the specified sites and/or selects to only search the default sites recommended by the server.” Specification, page 5, lines 15-17 (emphasis added). On the next page, the specification teaches that “[t]he shopper then selects and prioritizes the list of suppliers in order of descending preference.” *Id.*, page 6, lines 10-12. Even if claim 28 were not clear as to what is prioritized, a quick reference to the specification would have resolved any ambiguity.

“When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.” *Id.* (citing *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989)). The definition or redefinition of a claim term in the specification need not be explicit, but may be achieved “by implication.” *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268, 59 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2001) (“[A] claim term may be clearly redefined without an explicit statement of redefinition.”); *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344, 58 U.S.P.Q.2d 1059, 1065 (Fed. Cir. 2001). “In other words, the specification may define claim terms ‘by implication’ such that the meaning may be ‘found in or ascertained by a reading of the patent documents.’” *Bell Atl. Network Servs.* 262 F.3d at 1268 (quoting *Vitronics*, 90 F.3d at 1582 n.6, 39 U.S.P.Q.2d at 1577, 1578 n.6). Here, not only the actual wording of claim 28 requires prioritizing sources and not items, but the specification describes prioritizing as prioritizing of sources, and thus defines the term by implication.

If the Board does not accept the above arguments regarding claim 28, Applicant respectfully requests the Board to indicate how the claim may be amended to overcome the rejection in issue here. Would amending the sole clause of claim 28 to require “searching certain

data sources of the plurality of data sources in a prioritized order of the data sources specified by the user” overcome the rejection?

B. Claim 34

Claim 34 is set forth below:

34. A method for conducting on-line commerce, comprising the steps of:
- enabling a shopper to selectively designate a shopping list comprised of a plurality of different items, to be found in a single search, wherein the step of enabling is performed so as to enable the shopper to avoid searching for each different item of the plurality of different items one item at a time;
 - searching, during the single search, for each one of the plurality of different items in said shopping list on a plurality of data sources;
 - displaying information regarding said plurality of different items found during the single search; and
 - simultaneously purchasing on-line all or some of said plurality of different items in said shopping list.

On page 15 of the Appeal Brief, we argued that *simultaneously purchasing on-line all or some of said plurality of different items* requires simultaneous purchase of at least two different items. This is so because the limitation *simultaneously* would be meaningless in case of purchasing only a single item.

The objects of the last clause of claim 34 are “all or some of said plurality of different items” The Board concluded that “the purchase of one of the movies offered by Wells in Figures 2a or 2b constitutes a purchase of some (FF 7) of the offered movies because the selection of even a single movie makes determinate an otherwise indeterminate choice over not buying the movie at all.” Decision on Appeal at 7. This conclusion, however, clearly overlooks the *simultaneously* limitation. The meaning of the word *simultaneous* in the context of time is “existing or occurring at the same time; exactly coincident[.]” Merriam-Webster Online,

available online at <http://www.m-w.com>.² There must be at least two actions or occurrences that are simultaneous. The word simply loses meaning when it is applied to a single action or occurrence. There cannot be a simultaneous purchase of a single item. The purchase must take place coincident with some other purchase or action. Here, the limitation *simultaneously* qualifies the immediately following verb *purchasing*. The coincident actions therefore must be purchasing. The only objects of the last clause of the claim are *all or some items*. While FF7 essentially interprets *some* as *one or more*, it does not exclude application of the terms *all or some* to two or more items. The *simultaneously* limitation clearly mandates that at least two items are purchased, because an item cannot be purchased simultaneously with only itself.³

The Board's finding of fact 7 (FF 7) perhaps forces to the conclusion that "purchasing on-line all or some" means *purchasing on-line one or more*. It does not force the conclusion that "simultaneously purchasing on-line all or some" means the same thing. Such conclusion would ignore the *simultaneously* limitation. But all limitations must be considered.

The references do not disclose or suggest simultaneous purchasing of items, as is recited in claim 34. We respectfully submit that the Board's Decision overlooked this argument.

The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. 37 C.F.R. §41.50(c). If the Board does not accept the above arguments, Applicant respectfully requests the Board to indicate how claim 34 may be amended to overcome the rejection in issue here. Would amending the last clause of claim 34 to require "simultaneously purchasing on-line ~~all or some~~ at least two items of said

2 The Examiner used the same definition of this term. Office Action mailed on 8/24/2004, top of page 7.

3 Original claim 9 inartfully recited "simultaneously purchase one or more of the plurality of items." The claim was cancelled. The specification consistently used "simultaneously purchase" to describe purchasing of multiple items. Specification, page 2, lines 15-16; Abstract, lines 10-11 ("The shopper can simultaneously purchase selected ones of said items.")

plurality of different items in said shopping list” overcome the rejection?

C. Claim 36

Claim 36 specifies that the purchasing step includes “placing a single order for all items on the shopping list, at a corresponding data source, selected and approved by the user.”

We have argued that this claim is separately patentable for the same reason as was discussed in relation to claim 33. Appeal Brief at 20. The reason was that the references (and particularly Gavarini) do not disclose or suggest placing a single order for all of the plurality of different items. *Id.* at 17-18. We did not say that claims 33 and 36 stand and fall together. Realizing that the language of these two claims can be construed differently, we argued each of these claims under its own separate subheading.

The Board affirmed the rejection of claim 36 based on analysis of claim 33; there was no separate analysis of claim 36. Decision on Appeal at 7-8. The rejection of claim 33 was based on the recitation of verbiage “to be purchased” that is absent from claim 36. As the Decision on Appeal states, “claim 33 only uses the terms ‘to be purchased’ which does not equate to actual purchases as argued by Appellant.” *Id.* at 8. Claim 36 does not recite the terms “to be purchased” on which the rejection is based. The claim requires placing a single order for all items on the shopping list. The Board’s Decision overlooked this difference between claims 33 and 36, which Applicant argued separately.

If the Board does not accept the above arguments regarding claim 36, Applicant respectfully requests the Board to indicate how the claim may be amended to overcome the rejection in issue here.

IV
CONCLUSION

For the foregoing reasons, Applicant-Appellant respectfully submits that the rejections of claims 28, 34, and 36 should be reversed.

Respectfully submitted,

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